



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,724	11/03/2003	Les Rosen	P00111.P2	3536

28778 7590 05/04/2005  
JOHNSON & STAINBROOK, LLP  
3558 ROUND BARN BLVD., SUITE 203  
SANTA ROSA, CA 95403

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/699,724

**Applicant(s)**

ROSEN, LES

**Examiner**

Jonathan Ouellette

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 2 recites the limitation "means for reviewing verified *criminal* history of the worker" in the method of claim 1. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. **Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. (US 6,714,944 B1).**
6. As per **independent Claim 1**, Shapiro discloses a method for creating, editing and updating, verifying, and referencing a database of work, and education history (C4

L61-67, C5 L1-13), said method comprising the steps of: providing an internet service with secure means for prospective employees to enter and record on a database a personal educational and job history covering any time period (C7 L18-36); providing semi-automated means for verifying the history provided by the job applicant and for building a verified database of workers (Fig.2, C1 L32-51, C6 L35-54).

7. Shapiro fails to expressly disclose including licensing histories of workers in the background verification method.
8. However, Shapiro does disclose creating, editing and updating, verifying, and referencing a database of work and education histories, to include educational degrees and military ranks obtained by the user (C4 L61-67, C5 L1-13).
9. Furthermore, Official notice is given that licensing histories of workers was a well-known component of worker history and employment background checking at the time the invention was made.
10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included licensing histories of workers, in the system disclosed by Shapiro, for the advantage of providing a method for creating, editing and updating, verifying, and referencing a user's background information, with the ability to increase the effectiveness of the method by including a plurality of background information to be verified.
11. Furthermore, these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification

method would be performed regardless of the type of background information verified. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have verified licensing histories of workers as part of the background check, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
13. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. in view of Backgrounds Online (www.backgroundsonline.com, Retrieved from Internet Archive Wayback Machine <www.archive.org>, Date Range: 4/27/1999-10/6/2000).**
14. As per Claim 2, as understood by the examiner, Shapiro discloses providing a secure, confidential and private means for a prospective employer to review the verified education, employment, and licensing history of the worker (See Rejection of Claim 1; abstract, Fig.2, providing information for review).
15. Shapiro fails to expressly disclose providing means for reviewing verified criminal records.
16. However, Backgrounds Online discloses verifying and providing for review a criminal record background check (www.backgroundsonline.com, pg.4 and 7)

17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included providing means for reviewing verified criminal records, as disclosed by Backgrounds Online, in the system disclosed by Shapiro, for the advantage of providing a method for creating, editing and updating, verifying, and referencing a user's background information, with the ability to increase the effectiveness of the method by including a plurality of background information to be verified.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
19. The following foreign patent is cited to show the best foreign prior art found by the examiner:

**PCT No. WO 200133421 A1 to Gibbs et al.**

Gibbs discloses a candidate profile creating system for assisting a candidate in obtaining employment, which has modules for testing candidate skills, obtaining background checks, and training the candidate for interviews.

20. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

Art Unit: 3629

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
23. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

April 29, 2005



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600